UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. MARTIN

Appeal No. 2005-0215
Application No. 09/666,101

ON BRIEF

Before HAIRSTON, FLEMING, and NAPPI, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 7, 9 and 10.

The disclosed invention relates to a method and a circuit for varying the integration time of moving charges from a photodetector. The integration time of the moving charges is varied by selectively switching at least one additional charge well in parallel with a first charge well already receiving the moving charges from the photodetector.

Claim 7 is illustrative of the claimed invention, and it reads as follows:

> 7. A circuit for varying the integration time of moving charges from a photodetector comprising:
>
> a first charge well for receiving moving charges from a photodetector;
>
> at least one additional charge well; and
>
> means for selectively switching the at least one additional charge well in parallel with the first charge well to vary the integration time of the moving charges, based on a rate at which the moving charges fill the first charge well.

No references were relied on by the examiner.

Claims 7, 9 and 10 stand rejected under the first paragraph of 35 U.S.C. § 112 for lack of written description.

Claims 7, 9 and 10 stand rejected under the first paragraph of 35 U.S.C. § 112 for lack of enablement.

Reference is made to the supplemental brief, the reply brief and the answer for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the lack of written description and the lack of enablement rejections of claims 7, 9 and 10.

The examiner has set forth the following generic grounds for rejecting claims 7, 9 and 10 for lack of written description as well as lack of enablement under the first paragraph of 35 U.S.C. § 112:

> Regarding claims 7 and 9, the original specification does not teach a method of switching a charge well based on a rate at which moving charges fill a charge well, specifically a method of determining said rate, and a method of determining the proper time for switching.
>
> Regarding claim 10, the original specification does not teach a method of varying an integration capacitance based on a rate at which moving charges fill a charge well, specifically a method of determining said rate, and a method of determining the proper capacitance variation. [Answer, pp. 3-4.]

At the outset, we note that the written description requirement of the first paragraph of 35 U.S.C. § 112 is separate and distinct from the enablement requirement of the first paragraph of 35 U.S.C. § 112. In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985). Under the written description portion of the first paragraph of 35 U.S.C. § 112, the applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17, (Fed. Cir. 1991); In re Kaslow, 707 F.2d 1366,

1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). On the other hand, the test for enablement under the first paragraph of 35 U.S.C. § 112 is whether one reasonably skilled in the art could make or use the claimed invention from the disclosed subject matter together with information in the art without undue experimentation. United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1222-23 (Fed. Cir. 1988), cert. denied, 490 U.S. 1046 (1989). A disclosure can be enabling even though some experimentation is necessary. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384-85, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

Both of the rejections of record are reversed because of: (1) the lack of clarity as to what portion or portions of the grounds of rejection apply to the two distinctly different portions of the first paragraph of 35 U.S.C. § 112; and (2) the grounds of rejection failed to take into consideration the circuit in Figure 2 of the originally filed drawing, the overall explanation of the invention at page 3, lines 16 through 24 of the originally filed disclosure, the explanation of the Figure 2 circuit in the paragraph bridging pages 9 and 10 of the originally filed disclosure, and the originally filed claims which clearly explain to the skilled artisan that the additional

charge well must be selectively switched into parallel with the first charge well at whatever rate is needed to avoid saturation of the first charge well. More importantly, the examiner has not set forth any reason why the skilled artisan would not have known how to monitor the fill rate of the first charge well to avoid such a saturation condition.

In summary, we find that the burden of coming forward with evidence never shifted to the appellant since the examiner has not set forth a reasonable basis for questioning either the written description support or the enablement of the claimed invention.

DECISION

The decision of the examiner rejecting claims 7, 9 and 10 under the written description and the enablement portions of 35 U.S.C. § 112 is reversed.

REVERSED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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MICHAEL R. FLEMING) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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ROBERT E. NAPPI)
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KWH/hh

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